2/28/02

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jean M. Boudreau

Serial No. 75/503,725

George E. Kersey for Jean M. Boudreau.

J. Brett Golden, Trademark Examining Attorney, Law Office 102 (Thomas Shaw, Managing Attorney).

Before Hanak, Quinn and Bottorff, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Jean M. Boudreau (applicant) seeks to register LADYSGOLF.COM in typed drawing form for "on-line retail store services, computerized on-line ordering services featuring golf accessories, namely golf bags, golf clubs, golf balls, golf tees, golf flags, golf shoes, golf skirts and golf shirts." The intent-to-use application was filed on June 18, 1998.

The Examining Attorney has refused registration on two grounds. First, citing Section 2(d) of the Trademark Act, the Examining Attorney contends that applicant's

mark, when used in connection with applicant’s services, is likely to

cause confusion with the mark LADY GOLF previously registered in the form shown below for “women’s golf clothing; namely, shirts, pants, skirts and shoes” (Class 25); “women’s golf clubs, women’s golf gloves, golf bags, golf balls, and golf tees” (Class 28); and “retail golf store” (Class 42). Registration No. 1,941,535 issued December 12, 1995.

Second, citing Section 2(e)(1) of the Trademark Act, the Examining Attorney contends that applicant’s mark is merely descriptive of applicant’s services.

When the refusal to register was made final, applicant

appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

We will consider first the refusal pursuant to Section 2(d) of the Trademark Act.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.").

Considering first applicant's services and registrant's goods and services, we find that they are very closely related. The cited registration covers

retail golf store services. Applicant seeks to register its mark for on-line retail store services featuring a wide array of items that would be sold in golf stores, such as golf bags, golf clubs, golf balls, golf tees, golf shoes, golf shirts and golf skirts. Obviously, in recent years it has become

a common practice for retail stores to offer their services "on-line," that is, where a customer can order goods from the store using his or her personal computer without actually having to visit the store. Indeed, applicant itself has done precisely this. Moreover, the registered mark also covers golf related goods, such as golf clothing, golf clubs, and other golf accessories. These are the identical goods which applicant proposes to offer through its on-line retail store. Hence, applicant's on-line retail store services featuring various golf items and that portion of the cited registration featuring the identical golf items causes any differences in applicant's services and registrant's goods "to be of little or no legal significance." In re Hyper Shoppes, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed.

Cir. 1988).

Considering next the marks, we note at the outset that when applicant's services and registrant's services and goods are extremely similar as is the case here, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23

USPQ2d 1698, 1700 (Fed. Cir. 1992). We find that the first portion of applicant's mark (LADYSGOLF) is virtually identical to the registered mark in terms of visual appearance, pronunciation and connotation. The presence of the letter S in applicant's mark does very little to distinguish applicant's mark from the registered mark in terms of visual appearance, pronunciation or connotation. Likewise, the fact that the letter O in the registered mark looks like a golf ball on a tee does very little to distinguish the two marks because the relevant goods and services all involve golf equipment and golf apparel.

The only real point of difference between the two marks is that applicant's mark ends with ".COM." However, there is no serious dispute that the designation ".COM" (pronounced "dot com") refers to commerce on the Internet. Thus, in relation to applicant's on-line retail store services featuring various golf items, the ".COM" portion of applicant's mark is highly descriptive in that it readily informs consumers that applicant's on-line retail store services featuring a wide array of golf items are,

indeed, available on-line. A consumer familiar with registrant's mark LADY GOLF and design for retail golf store services and for a wide array of golf items, upon seeing applicant's mark LADYSGOLF.COM, would easily assume that registrant has now expanded its retail golf store services to offer said services on-line. Accordingly, we find that the contemporaneous use of applicant's mark for its on-line retail store services featuring a wide array of golf items is confusingly similar to the registered mark LADY GOLF and design for

conventional retail golf store services, and for a wide array of golf items. The refusal to register pursuant to Section 2(d) of the Trademark Act is affirmed.

We turn now to a consideration of whether applicant's mark is merely descriptive of its services. A mark is merely descriptive pursuant to Section 2(e)(1) of the Trademark Act if it immediately conveys information about a significant quality or characteristic of the relevant goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

At pages 3 and 4 of her reply brief, applicant appears

to argue that the word LADYSGOLF would bring to mind "the game of golf as played by ladies or women," and would not bring to mind applicant's services, namely, on-line retail store services, computerized on-line ordering services featuring golf accessories. We do not take issue with applicant that taken by itself the word LADYSGOLF would bring to mind golf played by ladies. However, the problem with applicant's reasoning is that

the mere descriptiveness of a mark is not judged in the abstract, but rather is judged in relation to the goods or services for which applicant seeks registration. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). When used in connection with on-line retail store services featuring golf accessories, applicant's mark LADYSGOLF.COM would immediately inform consumers that applicant's on-line retail store services feature golf accessories for ladies, and that applicant's on-line retail store services can indeed be accessed by a computer. In this regard, we have already discussed the highly descriptive nature of the ".COM" portion of applicant's mark. While not absolutely

dispositive, we also note in passing that the owner of the
registration for the cited mark LADY GOLF and design disclaimed the exclusive right to use "lady golf" apart from the mark in its entirety, thereby indicating that the term "lady golf" was merely descriptive of women's

golf clothing, women’s golf clubs and retail golf store services.

Decision: The refusal to register is affirmed pursuant to both Section 2(d) and Section 2(e)(1) of the Trademark Act.